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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,299	02/12/2004	Paul E. Share	13015/39281	5310
62127 7590 09/22/2011 VALSPAR SOURCING, INC. 901 3rd Avenue South PO Box 1461 MINNEAPOLIS, MN 55440-1461				
EXAMINER				
HUSON, MONICA ANNE				
ART UNIT		PAPER NUMBER		
1742				
MAIL DATE		DELIVERY MODE		
09/22/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/777,299

**Applicant(s)**

SHARE ET AL.

**Examiner**

MONICA HUSON

**Art Unit**

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-3,5-10,12,16-21 and 25-33 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-3,5-10,12,16-21 and 25-33 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-886)  
Paper No(s) Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s) Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

This office action is in response to the Amendment filed 7 July 2011.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-10, 12, 16-21, and 25-33 are rejected under 35 U.S.C. 103(a) as obvious over Venkateshwaran et al. (U.S. Patent 5,744,056), in view of Collette et al. (U.S. Patent 5,759,653). Regarding Claims 1, 5, 7, 10, 16, 21, and 25-29, Venkateshwaran et al., hereafter "Venkateshwaran," show that it is known to carry out a method (Abstract) comprising forming a preblend comprising a polyester (Column 6, line 45), a polyamide material (Column 6, line 44; 57-58), and an oxygen scavenging material (Column 4, lines 40-54; Column 6, lines 32-36); providing a base polyester (Column 12, lines 36-40: base resin~suitable packaging resin; Column 13, line 28; Column 14, line 13); introducing the preblend and the base resin into a mold apparatus, injection molding the admixture, and expanding the preform to provide a plastic container having a barrier layer (Column 12, lines 36-44; Column 10, lines 45-50); wherein the plastic container is stable during unfilled storage and the barrier layer has an oxygen scavenging property that is activated after filling the container with an aqueous fluid, wherein activation results from filling (Column 11, lines 59-67; Column 12, lines 1-5; Column 14, lines 50-66). Venkateshwaran notes that the amounts of polyester, polyamide, oxygen scavenging material, and base resin can vary (Column 8, lines 52-58; Examples 2-5), but he does not show the specifically claimed amounts. However, where the general conditions of a claim are disclosed by the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (MPEP 2144.05

(II)(A)). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use any appropriate ingredient percentages, such as those claimed, in order to provide the desired level of oxygen scavenging ability. Venkateshwaran does not discuss storage evaluations or comparisons. However, the references teach all the claimed ingredients, process steps, and process conditions and thus, the claimed effects and physical properties would implicitly be achieved by carrying out the disclosed process. If it is applicant's position that this would not be the case: (1) evidence would need to be provided to support applicant's position, and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching regarding how to obtain the claimed properties and effects by carrying out only these steps. Venkateshwaran does not show the specifically claimed aromatic polyamide or using cobalt. Collette et al., hereafter "Collette," show that it is known to carry out a method of making a bottle using a polymer containing m-xylylenediamine monomer units (col 10 line 51), wherein the oxygen scavenging material comprises cobalt or a metal complex thereof (col 10 lines 24-37). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Collette's specific polyamide because there is an art recognized suitability for using Collette's specific polyamide and cobalt in package-manufacturing methods such as Venkateshwaran's (MPEP 2144.07).

Regarding Claim 2, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the plastic container is a multilayer plastic container (Column 10, lines 50-51), meeting applicant's claim.

Regarding Claims 3, and 31-33, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the plastic container is monolayer (Column 10, lines 50-51). Venkateshwaran does not show the specific polyamide product. Collette shows it is known to make a bottle using a polymerization product of m-xylylenediamine and adipic acid (col 10 lines 51-52). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Collette's specific polyamide because there is an art

recognized suitability for using Collette's specific polyamide in package-manufacturing methods such as Venkateshwaran's (MPEP 2144.07).

Regarding Claim 6, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the preblend is in the form of solid particles (Example 2), meeting applicant's claim.

Regarding Claim 8, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 1 above, including a method wherein the diluent polyester comprises polyethylene terephthalate (Column 6, lines 45-46), meeting applicant's claim.

Regarding Claims 9, 18, 20, and 30, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 7 above, including a method wherein the base polyester contains PET, which would implicitly be bottle grade (Column 6, lines 37-46; Column 10, lines 40-45; Column 14, lines 13). The Examiner's position will be that any additional post consumer PET does not materially affect the basic and novel characteristics of the claimed invention because it provides PET material which would have the same or substantially the same structure as the virgin material.

Regarding Claim 12, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show the specific polyamide product. Collette shows it is known to make a bottle using a polymerization product of m-xylylenediamine and adipic acid (col 10 lines 51-52). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Collette's specific polyamide because there is an art recognized suitability for using Collette's specific polyamide in package-manufacturing methods such as Venkateshwaran's (MPEP 2144.07).

Regarding Claim 17, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not specifically show his base polyester in solid form. Collette shows making a bottle wherein the base polyester is in a form of solid particles (col 5 lines 59-67). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Collette's solid base polyester because there is an art recognized suitability for using Collette's solid

base polyester in package-manufacturing methods such as Venkateshwaran's (MPEP 2144.07).

Regarding Claim 19, Venkateshwaran shows the process as claimed as discussed in the rejection of Claim 9 above, including a method wherein the base polyester is polyethylene terephthalate (Column 13, lines 26-28), meeting applicant's claim.

### ***Response to Arguments***

With the exception of the Objection to claim 25 which has been withdrawn, applicant's arguments filed 7 July 2011 have been fully considered but they are not persuasive.

Applicant contends that Venkateshwaran and Collette and the instant invention use completely different oxygen-scavenging compositions. Although applicant is correct in that all three disclosures do not use the exact same oxygen-scavenging compositions, the examiner maintains that a combination of Venkateshwaran and Collette suggest the claimed composition of a polyester, a polyamide, and cobalt. Venkateshwaran shows using a blend comprising polyester and polyamide in Column 6, lines 37-58, and he discloses using iron as an oxygen-scavenging material in Column 4, lines 21-51. Collette shows using a composition comprising the specific polyamide of claim 12 and 31 in Column 10, lines 51-52, and either iron or cobalt as an oxygen-scavenging material in Column 10, lines 24-37. The examiner maintains that It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to Collette's specific polyamide and cobalt in Venkateshwaran's composition for the reasons originally given, and also because substituting equivalents known for the same purpose (e.g., iron or cobalt for oxygen scavenging) is obvious (MPEP 2144.04 (II)).

The examiner generally notes that oxygen scavenging function of any of the composition ingredients is no longer positively claimed. Further, the claimed composition does not exclude any other components that may be used in Venkateshwaran's composition.

Applicant contends that "whereas Collette uses a metal catalyst to promote the scavenging of oxygen by a polymer, the iron component of Venkateshwaran is not used as a catalyst, but rather is the actual material that reacts with and scavenges the oxygen". This is not persuasive because it is interpreted that since Collette discloses use of either iron or cobalt, and Venkateshwaran discloses use of iron, either iron or cobalt would both function in the appropriate fashion to promote scavenging of oxygen in the combined composition. The examiner maintains that a combination of Venkateshwaran and Collette fairly suggest an oxygen-scavenging composition comprising polyester, polyamide, and cobalt, and the fact that applicant has recognized another advantage, i.e. oxygen scavenging, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant contends that Venkateshwaran does not show the invention because he does not show the use of an oxygen-scavenging polymer. This is not persuasive because this is not claimed.

Applicant contends that Venkateshwaran does not show the specifically-claimed polyamide of claims 12 and 31. This is not persuasive because Collette was cited to show this feature. It is noted that Venkateshwaran does disclose the use of polyamides in Column 6, lines 37-44.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant contends that it would not have been obvious to use the claimed amount of cobalt. This is not persuasive because Venkateshwaran discloses that the

specific amounts of ingredients, including oxygen-scavengers, in the composition are known to be variable (Column 8, lines 52-58). Because the amounts of ingredients affect the functionality of the composition, i.e. they are result effective, the examiner maintains that because the general conditions of a claim are disclosed by the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (MPEP 2144.05 (II)(A)), and it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use any appropriate ingredient percentages, such as those claimed, in order to provide the desired level of oxygen scavenging ability. Further, the examiner notes that Collette shows using 1000 ppm of cobalt at Column 10, lines 23-37.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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